

REMARKS

At the time of the Office Action dated June 12, 2007, claims 1-17 were pending and rejected in this application.

**CLAIMS 1, 3, 6, 8-9, 11, 14, AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON BEN-SHAUL ET AL., U.S. PATENT NO. 6,976,090 (HEREINAFTER
BEN-SHAUL)**

On page 2 of the Office Action, the Examiner asserted that Ben-Shaul discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

On page 2 of the First Office Action, the Examiner asserted the following with regard to all of the rejected claims:

Ben-Shaul teaches a method and system (abstract) of providing content with annotated hyperlinks (col. 1, line 1 - col. 20, line 65 and col. 66, lines 15-20) such that a hyperlink map is built to facilitate the deactivation and reactivation of hyperlinks, or to change the hyperlink to point to a different server (col. 20, line 65 - col. 35, line 10; col. 41, line 10 - col. 42, line 5) and wherein online changes are reconciled ((col. 37, line 30 — col. 40, line 55).

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

and that such existence would be recognized by one having ordinary skill in the art.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in Ben-Shaul being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicants could cited substantially more case law. However, since the Examiner has signatory authority, Applicants proceed on the basis that the Examiner is already aware of the substance of this case law.

Simply put, the Examiner has not set forth a proper prima facie case of anticipation. The Examiner has (i) not identified all the elements of all the claims, (ii) not performed a claim construction on these terms, and (iii) not specifically identified, within the applied prior art, where each of the claimed elements are found. Instead, in one instance, the Examiner has cited 20 columns of text (i.e., columns 1-20) without explanation and with regard to another instance, the Examiner has cited 17 columns of text without explanation. Thus, the Examiner has not set forth a prima facie case of anticipation. Instead, the Examiner has essentially extended Applicants an invitation to read approximately 40 columns of text and guess/speculate (i) as to

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

what in Ben-Shaul the Examiner is relying upon to teach the claimed limitations and (ii) as to why.

Applicants also note that the Examiner has not even addressed any of the limitations recited in the dependent claims. Moreover, Applicants also note that the Examiner has only vaguely referred to certain of the claimed elements found in the independent claims and not referred to others. For example, Applicants are entirely unclear as to what limitation corresponds to the claimed "endpoint directives." Claim 1 also recites "annotating said served content with end point directives," yet the only passages in Ben-Shaul Applicants have been able to find, which discuss annotation, are lines 19-22 of column 19 and lines 24-26 of column 24, and Applicants are also unclear as to how these passages identically disclose the claimed annotating.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1, 4, 6, 8-9, 11, 14, and 16-17 under 35 U.S.C. § 102 for anticipation based upon Ben-Shaul is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 2, 4-5, 7, 10, 12-13, AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON BEN-SHAUL IN VIEW OF MASLOV, U.S. PATENT NO. 6,842,755**

On pages 3 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Ben-Shaul in view of Maslov to arrive at the claimed invention. This rejection is respectfully traversed.

On page 3 of the First Office Action, the Examiner stated the following:

Ben-Shaul does not expressly disclose how to best develop the hyperlink map. Maslov teaches a method and system (abstract) of developing document trees based on page hierarchies (col. 1, line 1 - col. 8, line 5; col. 10, lines 10-35), wherein modifications based on depth and reconciliation of ambiguities are performed (col. 8, line 5 - col. 10, line 10).

Applicants incorporate herein, as also applying to the present rejection, the arguments previously presented with regard to the Examiner's rejection based upon Ben-Shaul. Specifically, the Examiner has failed to specifically identify, within the applied prior art, teachings corresponding to the claimed elements. Moreover, Applicants also note that the Examiner has not even asserted a rationale to modify Ben-Shaul in view of Maslov. Thus, the Examiner has failed to establish a prima facie case of obviousness.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 2, 4-5, 7, 10, 12-13, and 15 under 35 U.S.C. § 103 for obviousness based upon Ben-Shaul view of Maslov is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 12, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320